

REMARKS

Applicants have carefully reviewed the contents of the Office Action mailed March 26, 2004. Reconsideration is respectfully requested in view of the foregoing amendments and the comments set forth below.

By this Amendment, claims 7 and 9-12 are amended. In addition, new claims 14-21 are presented. Accordingly, claims 1-21 are pending in the present application.

Claims 1-13 were rejected under 35 U.S.C. § 251 as lacking basis for reissue. The Action incorrectly indicates that no maintenance fees have been received for U.S. Patent No. 6,020,974, as evidenced by the attached U.S. Patent and Trademark Office Maintenance Fee Statement that indicates the 4 year maintenance fee as "PAID". In addition, the U.S. Patent and Trademark Office indicates that there are "No Fees to Pay" for the patent of which reissue is requested. Accordingly, it is submitted that U.S. Patent No. 6,020,974 is not expired and claims 1-13 do not lack basis for reissue under 35 U.S.C. § 251. Withdrawal of this rejection is requested.

The instant application is a reissue of unexpired patent No. 6,020,974. It is not a continuation and it is believed that no cross-reference is necessary, as stated in paragraph 2 of the Action. The Manual of Patent Examining Procedure does not mention a requirement to provide an amendment to the specification indicating that it is a reissue of a granted U.S. patent. The undersigned is not aware of a rule or law that requires such a cross-reference statement. The Examiner is requested to provide the rule that requires a cross-referencing in a reissue application, if such cross-referencing is required.

Item 3 of the Action states that a Certificate of Correction is necessary to make reference of 10/059, 398 (the present reissue application) in U.S. Patent No. 6,020,974. Since

Applicants must surrender U.S. Patent No. 6,020,974 in order for the instant reissue application to be allowed, a Certificate of Correction is not believed necessary since U.S. Patent No. 6,020,974 is to be surrendered.

Claim 12 was rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251 for the reasons set forth in paragraph 6 on page 4 of the Action. This rejection is respectfully traversed.

37 C.F.R. 1.175 states the requirements of the reissue declaration: (A) a statement that the applicants believes the original patent to be wholly or partly inoperative or invalid; (B) a statement of at least one error which is relied upon to support the reissue application; and (C) a statement that all errors which are being corrected in the reissue application up to the time of filing the oath/declaration arose without any deceptive intention on the part of the applicant in addition to those requirements set forth in 37 C.F.R. 1.63. The reissue application declaration filed by the inventors in the instant application is the form provided by the U.S. Patent and Trademark Office. This USPTO form states at least one error in the five sentences at the bottom of page 1 of the reissue declaration. According to the MPEP 1414 II, when more than one error is specified in the declaration and some of the designated “errors” are found to not be “errors” under 35 U.S.C § 251, any remaining error which is an error under 35 U.S.C. § 251 will still support the reissue (page 1400-22, column 2). In that only claim 12 was rejected as being based upon the defective reissue declaration, it is respectfully submitted that claims 1-11 and 13 are supported by the at least one error described at the bottom of page 1 of the reissue declaration. Accordingly, claim 12 should also be supported by the at least one error. Thus, it is believed that the Reissue Declaration is not defective and that withdrawal of the rejection to claim 12 under 25 U.S.C. § 251 should be withdrawn.

Claim 13 was rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,020,974. This is a reissue application of U.S. Patent No. 6,020,974. Thus, the patent of which claim 13 is rejected under the judicially created doctrine of obvious-type double patenting will be surrendered before the present reissue application can be allowed. Accordingly, this double patenting rejection should be moot.

Claims 7-12 were rejected under 35 U.S.C. § 251 as being an improper recapture of claimed subject matter as described in paragraph 8 spanning pages 6-11 of the Action. This rejection is respectfully traversed in view of the Board of Appeals and Interferences decision in Ex Parte Daniel M. Eggert and Frank Mikic (deceased), 67 USPQ2d 1716 (Bd Pat App & Int 2003) before an expanded panel of Administrative Patent Judges.

As explained in Ex Parte Eggert, the patent statute envisions that errors made without deceptive intent can be corrected after a patent has issued under defined circumstances (within two years of the patent being granted – 35 U.S.C. § 251). U.S. Patent No. 6,020,974 was granted on February 1, 2000. The present reissue application was filed on January 31, 2002 within the time period permissible to obtain broader claims. While the patent statute enables an applicant to enlarge the scope of his claims, there is a policy or doctrine known as the “reissue recapture rule”, which does not permit a patentee to recapture subject matter that was surrendered to obtain the granted patent.

Ex Parte Eggert clearly holds that there is not a per se rule of reissue recapture to prevent applicants from retreating from any claim limitation determined to have secured allowance of the original patent. According to the Board in Ex Parte Eggert, the first inquiry is to determine whether and in what aspect the reissue claims are broader than the rejected claims of the patented application. That is, the added claims of the present reissue

application should be compared to the original and once-amended claims of the 09/089,162 patent application, which matured into U.S. Patent No. 6,020,974. As correctly noted in the Action, claims 7 and 9 are broader than rejected claim 1 of application 09/089,162 in that an interface means element is not recited. The second inquiry is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. A review of the file history of 09/089,162 application indicates that claim 1, as originally filed, included the interference means. This claim was rejected. Accordingly, the claim was amended to recite line control means and caller information detecting means as well as a central control means. The once-amended claim still was rejected. Thus, it does not appear that the interference means was considered the patentable element of the claim.

As the Board explains in *Ex Parte Eggert*, the rejected claims constitute the surrendered subject matter under the “reissue recapture rule”. That is, an applicant cannot retreat back to the rejected claim language or a broader version thereof. However, the Board recognized the difficulties “in defining mechanical objects using the English language” and trying “to exclude ‘obvious’ embodiments from [a rejected] claim, yet retain all the non-obvious embodiments”. The Board held that claim drafting errors are correctable under the terms of 35 U.S.C. § 251. *Ex Parte Eggert* at 1718.

While it is true that the September 8, 1999 Amendment that placed the original application in condition for allowance contains a statement that mentions “the interface”, it is the “bell signal detection information” that is the subject of that statement. It is the addition of the bell signal detection means element to claim 1 that placed the application in condition for allowance, not the fact that the signal is transmitted over an interface. As stated above, unamended claims with the interface means were rejected.

The Board further opined that if a rejected claim contained elements ABC and a patented claim contained elements ABCDEF, “a reissue applicant cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside the outer circle (e.g. AB, BC, ABC_{BR}, etc.). Ex Parte Eggert at 1718. The Board did not hold that elements ABC must be claimed in a reissue application to avoid the recapture rule, but left open the possibilities of claims with elements ABDE, ACFG, ABDEF, etc. or other claims that include a part of the circle (AB or AC) and a portion outside the circle (e.g., D, E or F). Thus, the second and third steps determine “reissue recapture”.

As stated above, the second step or inquiry is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. The reissue claims are broader in the sense that not all the elements of the rejected claims are present (e.g., the interface means). However, it is submitted that the scope of the reissue claims is not the same or broader than the rejected original or once-amended claims of the ‘162 application.

The third step of the analysis as described on page 10 of the Action is to determine whether the reissue claims are materially narrowed in other respects to avoid the recapture rule. As stated above, the rejected claims do not include the bell signal detection means. Thus, claims 7 and 9 are materially narrower than the rejected claims even though they do not include the interface means which was included in the claim as originally filed. Contrary to the Action’s position, it is believed that claims 7 and 9 are materially narrowed in other respects with the recitation of bell signal detection means, which materially narrows the claims in other respects to avoid the recapture rule. That is, the reissue claims add a feature, the bell detection means, to the rejected claims, but delete the interface means. This is not broader in scope than a rejected claim and the recapture rule is avoided.

As the Action points out, claim 11 further includes the limitations of “display means for displaying the related information” and “memory means for storing relating information correspondence to the telephone number information” that were not included in allowed claim 1. While it is true that allowed claim 1 recites that the central control means has software to access and display information stored in the computer that is associated with the caller telephone number, nowhere does claim 1 recite a display means element and a memory means element as set forth in claim 11 of the present application. Thus, claim 11 of the present application is narrower than claim 1 of the patent in that it positively recites memory means for storing caller information corresponding to the telephone number information and display means for displaying the caller information. Thus, it is respectfully submitted that claim 11 of the present application is narrowed in other respects because the patent claim only recites central control means having telephone computer directory application software that accesses and displays information stored in the computer and not memory means and display means as recited in claim 11.

Claim 12 of the present application positively recites a computer with telephone computer directory application software in addition to the memory means for storing caller information and display means for displaying the caller information. Thus, it is submitted that claim 12 is materially narrowed in respects other than those in which the reissue claim was broadened (i.e., the omission of the interface means). On page 1724 of *Ex Parte Eggert*, the Federal Circuit emphasized its statement from Ball Corp v. United States, 729 F.2d 1429, 1435, 221 U.S.P.Q. 289, 294 (Fed. Cir. 1984) that “the recapture rule bars the patentee from acquiring through reissue, claims that are of the same or of broader scope than those claims that were canceled from the original application. As stated above, reissued claims 1, 7, 11 and 12 are not of the same scope as the rejected claims during the prosecution of the ’974

patent. In addition, these claims are narrower in other respects by including the recitation of elements that were not included in the rejected claims. Accordingly, claims 7-12 do not claim subject matter that was canceled or rejected in the original application and as a result, claims 7-12 cannot be an improper recapture of claimed subject matter.

The Federal Circuit in In re Clement, 131 F.3d 1464, 45 U.S.P.Q.2d 1161 (1997) held that if a reissue claim is narrower in an aspect germane to a prior art rejection and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim. Looking back at the prior art rejection in the March 2, 1999 Office Action of the '974 patent, the surrendered subject matter (rejected claim 1 (once amended)) as set forth in the December 18, 1998 Amendment, recited line control means, caller information detecting means, interface means, and central control means for transmitting the caller telephone number. Nowhere does this rejected or surrendered claim include a bell signal detection means (as in claims 7 and 9 of the present application) or a first detecting means for detecting a bell signal information (as in claim 11 and 12 of the present application). Since the addition of the bell signal detection means in claim 1 caused the application to mature into the '974 patent, it is believed that the bell signal detection means is an aspect germane to the prior art rejection. On the opposite side, the recitation of interface means in claim 1 did not preclude the prior art rejection and thus it is submitted that the interface means is an aspect unrelated to the rejection. As argued above, it is the bell signal detection means that was argued by the applicants to obtain the patent and the interface was merely mentioned in passing. Unlike In re Clement, the recitation of interface means was always present and was not added to overcome prior art rejections. Thus, it is submitted that claims 7-12 are narrowed in other respects that are related to a limitation which was added in an effort to overcome a prior art rejection. Accordingly, it is respectfully submitted that claims 7-12 avoided the recapture

rule by including features that materially narrowed the communication apparatus in respects other than those in which the reissue claims were broadened (and not germane to a prior art rejection).

Claim 11 was rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth in paragraph 9 of the Action. In particular, the Action requested clarification of the term “relating information”. By the foregoing amendments to the claims, “relating information” has been changed to “caller information” to clearly define the type of information being related on the display means. For example, this information is described in column 4, lines 38- column 6, line 20 of the ‘974 patent. Accordingly, claim 11 is believed to be fully definite under 35 U.S.C. § 112, second paragraph.

Claims 7-10 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,301,246 to Archibald, et al (hereinafter referred to as Archibald) as explained in paragraph 11 spanning pages 12-14 of the Action. This rejection is respectfully traversed. Archibald is directed to a data communications equipment security device using a caller party directory number. According to Archibald, when access is made to a computer from an outside telephone set, a modem determines whether or not the access is made to the computer, and when the access is allowed, a data stream is opened between the modem and the computer and caller information is transmitted from the modem to the computer (see column 5, lines 30-48 of Archibald). Independent claims 7 and 9 of the present application positively recite bell signal detection means for detecting a bell signal to produce a bell signal detection information when the bell signal is received from the telephone line and central means for activating a telephone computer directory software in the computer before the caller information detecting means detects the caller telephone number. Nowhere does Archibald disclose technology that its computer receives caller information and then starts a

software program as disclosed in claim 7 of the present invention.

According to Archibald, a CPU compares a calling party directory number (CPDN) to various lists for providing different forms of security. Thus, Archibald teaches a system where a calling party is allowed to access the computer if their telephone number is on one of the various lists. There is no reason to activate a telephone computer directory software before detecting a caller telephone number in Archibald. Thus, the structure and operation of Archibald is quite different from the invention recited by claims 7 and 9.

Archibald discloses a method of accessing a computer through a data communications equipment (DCE), for example, a modem, wherein the DCE stores a plurality of lists, each list including a plurality of calling party directory numbers (CPDN's) wherein an incoming call including a CPDN number provided by the local telephone service is compared with the CPDN numbers in the stored lists in the modem to determine whether access should be granted to the computer. Thus, Archibald is directed to an invention where security is provided so that access to the computer is conditioned on whether or not a caller's CPDN number is on one of the various lists. This is not Applicants' invention.

The Action suggests that the alleged bell signal detecting means may be a digital signal processor 230. However, nowhere does Archibald disclose that its data signal processor (DSP) produces a bell signal detection information when the bell signal is received from the telephone line and that a central means transmits the bell signal detection information to the computer to activate a telephone computer directory software in the computer before said caller information detecting means detects the caller telephone number (claim 7); or a central control means for activating a telephone computer directory application software in the computer by detecting the bell signal information by the bell signal detecting means and, after detecting a telephone call member information by the caller information

detecting means, for causing the software to retrieve an display information that is stored in the computer and associated with the caller telephone number (claim 9). Accordingly, Archibald fails to disclose each and every claimed element of claims 7-10. Consequently, Archibald cannot anticipate claims 7-10 and withdrawal of that rejection is respectfully requested.

Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Archibald in view of JP 0913972A as explained in paragraph 12 spanning pages 14-17 of the Action. This rejection is respectfully traversed.

Archibald discloses nothing whatsoever regarding the activation of a computer telephone directory when a call is originated much less activating the telephone computer directory in response to an incoming telephone call. Japanese publication '792 discloses that help information of a facsimile machine is stored in the computer and when a help key of the facsimile machine is depressed, the help information is transmitted from a computer to the facsimile machine so that the information is displayed on a display portion of the facsimile machine. The gist of the invention in the Japanese publication is that reduction in capacity of a memory of a facsimile machine is compensated by the memory of the computer. Nowhere does the Japanese publication address activating a telephone computer directory software in a personal computer as claimed by Applicants. Consequently, even if Archibald was modified by Japanese publication '972, Applicants' invention would not result because neither reference discloses, teaches or suggests a central control means that activates a telephone computer directory software in a personal computer before a caller information detecting means detects a caller telephone number. In view of the above, it is believed that claims 11 and 12 are patentable over any combination of Archibald and Japanese publication '972.

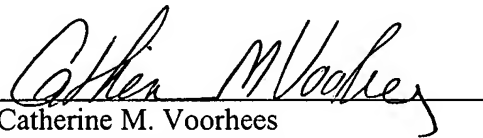
In addition, new claims 14-21 are presented, which are based on allowed claims 1-6 but recite the elements as units and in method claims. It is believed that these claims are patentable over the prior art of record since they are based on allowed claims 1-6. An early and favorable reconsideration of the instant application is requested and a Notice of Allowance indicating that claims 1-21 are allowed over the prior art of record is requested.

Twenty-one (21) claims are pending in the application. Accordingly, attached is a check for \$18.00 for the additional claim. Should no check be attached, the Commissioner of Patents is authorized to charge Deposit Account No. 22-0261, and to charge any additional fees required in connection with this Amendment.

Should the Examiner believe that a conference with the undersigned representative will advance the prosecution of the instant application, the Examiner is encouraged to telephone the undersigned at the number listed below.

Respectfully submitted,

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